



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,524	12/13/2000	Weishi Huang	CSCO-90241	9867

7590 04/23/2004
WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,524

Applicant(s)

HUANG, WEISHI

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Pacifici et al. (hereinafter Pacifici, U.S. Patent No. 6,230,171).

In regard to independent Claim 1 (and similarly independent Claims 9, 17, and 25), Pacifici teaches that Fig. 2 illustrates how the markup system interacts with the client-side manager and the Web browser. In the preferred embodiment, the collaboration server (112) (Fig. 1) described above, inserts a JavaScript function implementing the markup system that then is invoked inside every shared document (214) displayed by the Web browser (116). After the Web browser terminates loading and displaying the shared document it runs the JavaScript-based markup system inside the browser's virtual machine. The markup system (210) captures the user's keyboard input events or mouse clicks over particular locations of the shared document (214). When a user action event is captured the markup system (210) responds by generating HTML components (212) that are loaded and added to the document dynamically. These dynamic HTML components (212) realize the annotation elements (Col. 4, lines

27-42; compare to Claim 1 (and similarly Claims 9, 17, and 25), “... **(a) displaying said Web page within a first window on a display device of a computer system; (b) generating a second window within said first window, said second window for receiving information comprising at least a portion of said Web page; (c) receiving user input comprising remarks associated with a position within said Web page; and (d) creating an edited version of said Web page, said edited version comprising said remarks indexed to said position**”).

In regard to dependent Claim 2 (and similarly dependent Claims 10, 18, and 26), Pacifici teaches annotating HTML documents (Col. 4, lines 9-13; compare to Claim 2 (and similarly Claims 10, 18, and 26, “... **said Web page is in an HTML (HyperText Markup Language) format**”).

In regard to dependent Claim 3 (and similarly dependent Claims 11, 19, and 27), Pacifici teaches that after the Web browser terminates loading and displaying the shared document (first window) it runs the JavaScript-based markup system inside the browser's virtual machine (creating a second window). The markup system (210) captures the user's keyboard input events or mouse clicks over particular locations of the shared document (214) (Col. 4, lines 33-38; compare to Claim 3 (and similarly Claims 11, 19, and 27), “... **said information received by said second window is a copy of said Web page displayed in said first window**”).

In regard to dependent Claim 4 (and similarly dependent Claims 12, 20, and 28), Pacifici teaches that in the pointer plane (312), a virtual pointer is used by the presenter to focus the attention of the audience to a certain area of the shared document. In the

text/draw plane, text and drawing annotations can be added on top of the original document. The highlight plane allows for accentuation of the areas of the document, effectively simulating use of a highlight pen on normal paper. In the preferred embodiment, each virtual plane, is used to implement a different markup functionality utilizing dynamic HTML (Col. 5, lines 58-67; compare to Claim 4 (and similarly Claims 12, 20, and 28), “... **providing with said second window a user interface that provides a reference scheme for identifying said position within said Web page**”).

In regard to dependent Claim 5 (and similarly dependent Claims 13, 21, and 29), Pacifici teaches that highlighting is defined as the ability to change the background color of a portion of the document. To achieve this effect, a full original document is placed at the time of loading it, inside a layer with transparent background (316), and is positioned in the Z-dimension in a virtual plane above the highlight plane (318), as indicated in Fig. 3. When the presenter highlights a portion of the document, an opaque layer (322) is created with the required position and dimensions inside the highlight plane (318). The background color of this layer represents the highlighting color (Col. 6, lines 58-67; compare to Claim 5 (and similarly Claims 13, 21, and 29), “... **receiving position information identifying a beginning point and an ending point of a character string corresponding to said position within said Web page**”).

In regard to dependent Claim 6 (and similarly dependent Claims 14, 22, and 30), Pacifici teaches that the markup system (210) captures the user's keyboard input events or mouse clicks over particular locations of the shared document (214). When a user action event is captured the markup system (210) responds by generating HTML

components (212) that are loaded and added to the document dynamically. These dynamic HTML components (212) realize the annotation elements (Col. 4, lines 35-42; compare to Claim 6 (and similarly Claims 14, 22, and 30), “... ***providing with said second window a user interface comprising fields for receiving said remarks and said position information***”).

In regard to dependent Claim 7 (and similarly dependent Claims 15, 23, and 31), Pacifici teaches that highlighting is defined as the ability to change the background color of a portion of the document. To achieve this effect, a full original document is placed at the time of loading it, inside a layer with transparent background (316), and is positioned in the Z-dimension in a virtual plane above the highlight plane (318), as indicated in Fig. 3. When the presenter highlights a portion of the document, an opaque layer (322) is created with the required position and dimensions inside the highlight plane (318). The background color of this layer represents the highlighting color (Col. 6, lines 58-67; compare to Claim 7 (and similarly Claims 15, 23, and 31), “... ***highlighting in said edited version a character string corresponding to said position within said Web page***”).

In regard to dependent Claim 8 (and similarly dependent Claims 16, 24, and 32), Pacifici teaches that the collaboration server (112) is a system component that is responsible for retrieving Web-material that is referenced via URL addresses (Col. 4, lines 46-48; compare to Claim 8 (and similarly Claims 16, 24, and 32), “... ***said Web page and said edited version of said Web page are identified by Uniform Resource Locators (URLs)***”).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
04/09/04


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER